

REMARKS

In order to emphasize the patentable distinctions of applicants' contribution to the art, claim 32 has been amended to incorporate the subject matter of claim 34, whereby claim 32 now recites a toroid having an inner side surface, an outer side surface, a top and a bottom. Claim 32 has been further amended to incorporate, in the alternative, subject matter previously delineated by claims 35 and 36. In particular, the step of containing the toroid within a milling assembly now requires at least one of placing an inner ring circumferentially about at least a portion of the inner side surface and placing an outer ring circumferentially about at least a portion of the outer side surface.

For the sake of clarity, claims 35-39 have been amended to depend from claim 32 instead of claim 34. Furthermore, the inner and outer ring features formerly recited in claim 38 have been removed, these features instead now being inherited from amended base claim 32. Claims 63-65 have been amended to depend from claim 62 instead of claim 32.

Support for the amendment of claims 32, 35-39, and 63-65 is provided by the original specification; particularly at page 5, lines 1-2, 6-11, and 19-21; page 6; and page 7, lines 1-2; and claims 22-23 and 25-28 as originally filed. Consequently, no new matter has been added.

Claim 34 has been cancelled without prejudice to expedite prosecution of this application. Claims 20-31 were cancelled previously.

Claims 1-19, 33, 48-49, and 54-65 stand withdrawn as being directed to a non-elected invention.

Applicants' invention, as recited by remaining claims 32, 35-47, and 50-53, provides a method for manufacturing a soft magnetic metal electromechanical component. Generally stated, the method comprises the steps of winding soft magnetic metal into a toroid; containing the toroid within a milling

assembly; applying an adhesive to the toroid; curing the adhesive; milling the toroid into an electro-mechanical component shape; and thermally processing the electro-mechanical component shape into an electro-mechanical component. The containment afforded by the milling assembly permits reliable and efficient manufacture of the present component. Fracture and delamination of the ribbon-form material are mitigated or eliminated, preventing mechanical and magnetic degradation of the present component. These difficulties are especially likely to occur when manufacturing components that employ hard and brittle materials, such as amorphous metal ribbon.

The Examiner has maintained the restriction requirement set forth in the prior Office Action dated August 1, 2006, and has extended that requirement with respect to claims 60-65 submitted by way of applicants' amendment filed on February 27, 2007. In particular, the Examiner has now classified the invention of Group III as follows:

- III-A. Claim 60, drawn to a process that includes applying an adhesive with an atmospheric soak process, classified in class 156, subclass 314;
- III-B. Claim 61, drawn to a process that includes providing a vessel containing the adhesive, classified in class 156, subclass 285;
- III-C. Claim 33, drawn to a process that includes removing a toroid from a milling assembly, classified in class 29, subclass 426.2;
- III-D. Claims 35-53 and 55-59, drawn to a process that includes placing an inner ring, an outer ring, and a hat, classified in class 29, subclass 609;
- III-E. Claims 48 and 49, drawn to a process that specifically mills with a cutting tool, classified in class 409, subclass 66; and

III-F. Claims 62-65, drawn to a process of curing an adhesive at a heat treating temperature and thermal processing, classified in class 156, subclass 307.1.

The Examiner has alleged that the inventions of Groups III-A through III-F are directed to related inventions of a magnetic metal and that each Group has a materially different design, e.g. manufacturing process. By way of the amendment dated 23 August, 2006, applicants elected, with traverse, the invention of Group III, and within Group III, the invention of Group III-D (i.e., original claims 35-53 and 55-59). In the Office Action dated November 24, 2006, applicants' traverse was noted but the restriction requirement was made final. Accordingly, claims 1-19, 22-31, 33, 48, 49, and 54-59 were withdrawn as being directed to a non-elected invention. The November 24, 2006 Office Action further considered claims 35-53, but not claims 55-59, on the merits. The present Office Action confirms the continuing election of the invention of Group III-D, it being noted since an action has already been taken on the merits for the originally presented invention of Group III-D, said invention has been constructively elected.

In the present Office Action, the Examiner has further acknowledged that claims 32 and 34 link the allegedly separate species of Groups III-A through III-F.

The Examiner has correctly inferred the presence of a typographical error in claims 63-65 of Group III-F. Applicants express appreciation for the Examiner's constructive action to advance prosecution of these claims. In accordance with his suggestion, claims 63-65 have been amended to depend from claim 62 instead of claim 32.

Claims 32, 34-47, and 50-53 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32, 34-47, and 50-53 of US Patent Application Serial No. 10/876,034 in view of Decristofaro et al.

In order to expedite prosecution of this application, enclosed herewith is a Terminal Disclaimer in the form required by 37 CFR 1.321 (b). The Terminal Disclaimer includes a statement by the assignee specifying that the evidentiary documents have been reviewed and certifying that, to the best of the inventor's knowledge and belief, title is in the assignee seeking to take action. As such, the Terminal Disclaimer is submitted to be in compliance with 37 CFR 3.73 (b), and is in the proper form required by 37 CFR 1.321. In view of the same, it is submitted that claims 32, 34-47, and 50-53 should not be subject to rejection based on obviousness-type double patenting over claims 32, 34-47, and 50-53 of pending U.S. Patent Application Serial No. 10/876,034 in view of Decristofaro et al.

Accordingly, reconsideration of the rejection of claims 32, 34-47, and 50-53 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32, 34-47, and 50-53 of pending U.S. Patent Application Serial No. 10/876,034 in view of Decristofaro et al. is respectfully requested.

Claims 32 and 34 were rejected under 35 USC 102(e) as being anticipated by US Patent No. 6,803,694 to Decristofaro et al., which is directed to a unitary amorphous metal magnetic component for an axial flux electric machine such as a motor or generator. Inasmuch as claim 34 has now been cancelled, this rejection will be addressed with respect to claim 32 as now amended.

In particular, claim 32 has now been amended to incorporate the limitations formerly recited by claims 34-36. The Examiner has indicated that claims 35 and 36 would be patentable if presented in

independent form and if the provisional double patenting rejection discussed above were to be mooted by filing of a suitable terminal disclaimer. Each of claims 35 and 36 originally depended from claims 32 through intervening claim 34. It is respectfully submitted that the aforementioned provisional double patenting rejection has been so mooted and that the amendment of claim 32 to recite, in the alternative, the subject matter delineated by previous claims 35 and 36 places amended claim 32 in an independent form that is patentable over Decristofaro et al. and that is not subject to any double patenting rejection.

It is further submitted that amended claims 35-36, 39-47, and 50-53, which all depend from claim 32, are patentable for at least the same reasons.

Accordingly, reconsideration of the rejection under 35 USC 102(e) of claims 32 and 34 over Decristofaro et al. is respectfully requested.

Claim 37 was rejected under 35 USC 103(a) as being unpatentable over Decristofaro et al. in view of US Patent No. RE 28,559 to Villano, which provides an apparatus for milling Swiss-type screw machine cams.

The Examiner has acknowledged that Decristofaro et al. fails to mention a milling assembly that includes a hat, and therefore has pointed to Villano as allegedly teaching a process that includes a milling assembly that can be broadly read as disclosing such a hat.

As amended, claim 37 depends from claim 32, which is submitted now to recite subject matter the Examiner has deemed allowable. Applicants thus submit that amended claim 37 is also patentable over the art of record.

Accordingly, reconsideration of the rejection of claim 37 under 35 USC 103(a) as being unpatentable over Decristofaro et al. in view of Villano is respectfully requested.

The Examiner has indicated that claims 38-47 and 50-53 also recite allowable subject matter. He has objected to these claims as being dependent on a rejected base claim, but has indicated they would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims. Each of these claims depends directly or indirectly from amended base claim 32, which is submitted to be patentable for at least the reasons set forth hereinabove. Accordingly, it is submitted that claims 38-47 and 50-53 are also allowable. Reconsideration of the objection thereto is respectfully requested.

Applicants respectfully submit that the indication of the withdrawal of claims 55-59 in the Office Action Summary (Form PTOL-326) included in the present Office Action was apparently given inadvertently. In particular, the Election/Restriction Requirement of the present Office Action (pp. 2-3) included claims 55-59 within Group III-D. In applicants' response dated 23 August 2006, Group III-D was elected for further prosecution on the merits. The Examiner has further confirmed the constructive election of the claims of Group III-D, inasmuch as an action on the merits has been entered on the claims of Group III-D.

It is respectfully noted that applicants' response dated February 27, 2007 included remarks noting the apparent absence of any consideration of claims 55-59, notwithstanding their election as part of Group III-D. That response further requested appropriate consideration of claims 55-59. Applicants are unaware of any further basis on which claims 55-59 might have been withdrawn, and no other statutory rejection of these claims is included in the present office action.

Accordingly, it is submitted that claims 55-59 should not have been withdrawn from prosecution and that applicants are entitled to examination of said claims on the merits. Claims 55-59

are believed to be patentable over the art of record for at least the same reasons as set forth hereinabove with respect to claim 32.

Reconsideration of the withdrawal of claims 55-59 of elected Group III-D and examination of said claims on the merits and their allowance are respectfully requested.

As noted above, the Examiner acknowledged in the present Office Action that the inventions designated as belonging to Groups III-A through III-F are linked by generic claim 32. It is respectfully submitted that amended claim 32 remains generic to the claims of Groups III-A through III-F and is allowable. Applicants thus respectfully request rejoinder of all the claims delineated in Groups III-A through III-F, specifically: claim 60 of Group III-A; claim 61 of Group III-B; claim 33 of Group III-C; claims 48-49 of Groups III-D and III-E; claims 62-65 of Group III-F, along with claims 55-59 of Group III-D. Each of these claims presently stands withdrawn as being directed to a non-elected invention. However, it is submitted that upon allowance of generic claim 32, applicants are entitled to such rejoinder and examination under 37 CFR 1.104. It is respectfully noted that claims 33, 48-49, and 60-65 all depend directly or indirectly from amended claim 32. Applicants accordingly request rejoinder of claims 33, 48-49, and 60-65 and maintain that each of said claims, as amended, is allowable over the art of record for at least the same reasons as set forth hereinabove in connection with the rejections over Decristofaro.

In view of the amendment of claims 32, 35-39, and 63-65; the cancellation of claim 34; the Terminal Disclaimer submitted herewith; and the foregoing remarks, it is submitted that the present application has been placed in allowable condition. Entry of the present amendment; reconsideration of the objection to claims 35, 36, 38-47, and 50-53, the rejection of claims 32, 34-47, and 50-53, and

the withdrawal of claims 55-59; rejoinder of claims 33, 48-49, and 60-65 and their examination, together with claims 55-59; and allowance of the present application, together with amended claims 32-33, 35-53, and 55-65, are earnestly solicited.

Respectfully submitted,
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